REMARKS

Claims 1-23 are pending in this application. Claims 1, 5-11, 13, 15, 16, and 18-22 were rejected under 35 U.S.C. § 102(e). Claims 2-4, 12, 14, 17, and 23 were rejected under 35 U.S.C. § 103.

Applicants expressly reserve the right to pursue prosecution of any presently excluded subject matter or claim embodiments in one or more future continuation and/or divisional application(s). Applicants have carefully considered the points raised in the Office Action and believe that the Examiner's concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Rejection under 35 U.S.C. §102

Claims 1, 5-11, 13, 15, 16, and 18-22 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Margaron, *et al.* (U.S. Patent Application Publication No. 2003/0083649, "Margaron"). Applicants respectfully traverse this rejection.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI, 1990) (emphasis in original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' " Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); M.P.E.P. §2112.

The claimed invention is directed to methods to treat macular edema comprising administering photosensitizer (PS) to a subject afflicted with macular edema and irradiating the macula of the subject with light having a wavelength absorbed by the PS.

Margaron describes the use of low dose PDT for reducing or preventing undesirable inflammation resulting from a previous normal dose PDT treatment of a subject diagnosed or afflicted with various ocular diseases including diabetic macular edema. In discussing Margaron, the Examiner states that "in the teaching "which method comprises exposing a target tissue in a subject that had been treated with normal dose PDT treatment to low light..." (paragraph [0010]), the target tissue would be the macula where the subject is afflicted with diabetic macular edema (paragraph [0012, line 8)." Office Action, page 4, emphasis added. Applicants respectfully disagree with this interpretation of Margaron.

Although Margaron lists diabetic macular edema as a disease to be treated, Margaron does not teach irradiation of the macula for the treatment. Margaron describes in paragraph 40 that "target tissue" "refers to tissues and/or regions of a subject selected from PDT treatment" but is silent with regard to specific tissue to be targeted for treatment of macular edema. The instant specification teaches that macular edema can have causes outside of the macula and, with regard to the claimed invention, makes clear that "the treatment is directed to the macula, even if the underlying cause or etiology of the macular edema is located elsewhere." Specification, page 5, lines 5-7. Irradiation of the macula is required for the claimed methods and nothing in Margaron teaches this.

For a claim to be anticipated by a reference, the reference much teach each and every element of the claim. Applicants respectfully submit that the Examiner has not shown that irradiation of the macula necessarily flows from the target tissues described in Margaron. Thus, Applicants respectfully submit that Margaron does not anticipate the claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102(e).

Rejection under 35 U.S.C. §103

Claims 2-4, 12, 14, 17, and 23 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Margaron. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the subject matter of Margaron and the instant claimed subject matter were, at the time the invention was made, owned by or subject to an obligation of assignment to the same entity, QLT, Inc. Thus, according to 35 U.S.C. §103(c), the §102(e) reference of Margaron shall not preclude patentability under 35 U.S.C. §103. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

CONCLUSION

Applicants believe that all issues raised in the Office Action have been properly addressed in this response. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If the Examiner feels that a telephone interview would serve to facilitate resolution of any outstanding issues, the Examiner is encouraged to contact Applicants' representative at the telephone number below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 273012013101. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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